

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number 038190/233565

(filed with the Notice of Appeal)

Application Number 09/848,519

Filed May 4, 2001

First Named Inventor David G. Beshore

Art Unit 3623

Examiner Johnna Ronee Loftis

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Respectfully submitted,



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REMARKS/ARGUMENTS

These remarks are hereby filed concurrent with a Pre-Appeal Brief Request for Review. The present application includes pending Claims 1-20, all of which stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the publication Susann Wilkinson, *Evaluation Report for Grant #R13 HG00793-0142: Impact of Human Genome Initiative on Society: A Women's Study Approach* (hereinafter "Wilkinson"), in view of Official Notice of facts outside the record. As explained below, however, Applicant respectfully submits that the claimed invention is patentably distinct from Wilkinson, alone or in view of any Official Notice; and accordingly, respectfully request reconsideration and reversal of the final rejection of all of the pending claims of the present application.

I. Claims 1-14 are Patentable over Wilkinson

As explained in response to the final Official Action, in contrast to independent Claim 1, and similarly independent Claim 7, Wilkinson does not teach or suggest assessing a process of an organization according to a method that includes (a) developing preliminary findings based upon information concerning the organization and the process, including characterizing and labeling the findings as either a strength or weakness; (b) electronically voting for agreement or disagreement with each finding (or with the characterization of each finding); and then (c) developing final findings based upon the vote, including characterizing and labeling the final findings as a strength or weakness. While the Examiner concedes that Wilkinson does not teach or suggest findings including characterization labels, the Examiner takes Official Notice that it would have been obvious to label the alleged findings in Wilkinson with strength/weakness characterizations, the alleged motivation being to provide more information for the assessor to enable him/her to provide the most accurate assessment of the organization. Applicant respectfully disagrees, and separately addresses a number of deficiencies in the rejection.

A. Inherency of Strength/Weakness Characterizations

The Official Action appears to concede that Wilkinson does not explicitly disclose preliminary or final findings having associated strength or weakness characterizations. Nonetheless, the Official Action alleges that this feature is inherent in Wilkinson since such characterizations are subjective and that, while the theoretical principles presented to the participants for agreement voting mostly include strengths, one or more of those principles may be viewed by some as weaknesses. To the contrary, however, even if the principles disclosed by Wilkinson could have associated strength/weakness characterizations, this does not establish inherency of such characterizations in Wilkinson. Rather, establishing inherency of the aforementioned feature requires evidence establishing that principles necessarily do include such characterizations, as opposed to a probability or possibility of including those characterizations. As disclosed in the MPEP, the Examiner bears the burden of establishing inherency in the prior art. More

particularly, as explained in the MPEP, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or in technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” MPEP § 2112, *quoting Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In the instant case, the Examiner has failed to provide any facts or technical reasoning to support her conclusion that Wilkinson inherently discloses the aforementioned strength/weakness characterizations. The Examiner does allege that most of the principles are characterized as inherent strengths. But not only does the Examiner fail to provide facts or technical reasoning for her conclusion that most of the principles are inherently characterized as strengths, but her allegation does not support that the principles inherently include strength/weakness characterizations in the first place. In fact, in the only substantive attempt to provide such reasoning to support the inherency of characterizations, proffered in the second Official Action (see page 3), the Examiner’s explanation clearly demonstrated that the principles of Wilkinson do not necessarily, and thus inherently, include associated strength/weakness characterizations, similar to the claimed invention.

In contrast to the allegation of the Official Action, Applicant respectfully submits that nothing in Wilkinson teaches or suggests, explicitly or inherently, that the items of the participant questionnaires are characterized as strengths or weaknesses (i.e., have associated characterizations selected from a group consisting of a strength or a weakness), as recited by the claimed invention. As is well understood by those skilled in the art, characterizations such as those recited by the claimed invention may be considered traits, qualities or properties that at least partially distinguish respective entities from one another. *See* Merriam-Webster Online Dictionary, *Characteristic* (visited Feb. 27, 2006) <<http://www.m-w.com/dictionary/characteristic>> (explaining that characteristics may be defined as distinguishing traits, qualities or properties). In accordance with the claimed invention, then, the recited characterizations at least partially distinguish the findings from one another. Nothing in Wilkinson, however, teaches or suggests that the items of a questionnaire have associated traits, qualities or properties that serve to distinguish the items from one another, much less in any manner that could reasonably be interpreted to correspond to a strength or a weakness.

B. Improper Official Notice

The Official Action concedes that Wilkinson does not teach or suggest labeling the theoretical principles that guided the process of organizing the meeting, shown in Table 3 of Wilkinson (allegedly corresponding to preliminary/final findings) with strength/weakness characterizations, similar to the findings of the claimed invention. Nonetheless, the Official Action takes Official Notice that one skilled

in the art would have found it obvious to modify Wilkinson to include this feature, with the alleged motivation being to provide more information for the assessor to enable him/her to provide the most accurate assessment of the organization. Applicant respectfully disagrees.

According to MPEP § 2144.03(A.), Official Notice can only be taken of facts that are “capable of instant and unquestionable demonstration as being well-known.” Citing *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970), the MPEP continues by explaining that “the notice of facts beyond the record which maybe taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy dispute.’” Applicants respectfully submit that the Official Action did not, in fact, take Official Notice of facts capable of instant and unquestionable demonstration as being well known so as to defy dispute. If, as alleged (but expressly not admitted), the theoretical principles that guided the process of organizing the meeting, shown in Table 3 of Wilkinson (allegedly corresponding to preliminary/final findings) inherently reflect their characterizations as strengths/weaknesses, then those principles must necessarily reflect their characterizations. If the principles necessarily reflect their characterizations, as alleged (but expressly not admitted), one could argue that those skilled in the art could just as easily interpret the inherently-reflected characterizations without labels identifying those characterizations, contrary to the Official Notice taken by the Examiner.

Thus, the Official Action has taken Official Notice that it would have been obvious to label the theoretical principles of Table 3 of Wilkinson with their inherently-reflected strength/weakness characterizations. Applicant respectfully submits, however, that it is equally plausible that if the theoretical principles inherently reflect strength/weakness characterizations, as alleged (but expressly not admitted), one skilled in the art could interpret those characterizations without any labels identifying those characterizations. Therefore, Applicant respectfully submits that the assertion that it would have been obvious to label the theoretical principles of Table 3 of Wilkinson with their inherently-reflected strength/weakness characterizations is not capable of instant and unquestionable demonstration as being well known so as to defy dispute, as required to take Official Notice of facts not in the record.

C. No Motivation to Modify Wilkinson

Although the Official Action alleges that the theoretical principles that guided the process of organizing the meeting, shown in Table 3 of Wilkinson (allegedly corresponding to preliminary/final findings), inherently reflect strength-weakness characterizations, the Official Action alleges that would have been obvious to one skilled in the art to label the principles with their characterizations to “provide more information for the assessor to enable him or her to provide a most accurate assessment of the organization.” Official Action of November 29, 2006, page 4. Applicant respectfully disagrees, and

respectfully submits that one skilled in the art would not have been motivated to modify Wilkinson to include characterization labels.

As explained above, if the principles necessarily reflect their characterizations, as alleged (but expressly not admitted), one could argue that those skilled in the art could just as easily interpret the inherently-reflected characterizations without labels identifying those characterizations. In other words, if the theoretical principles that guided the process of organizing the meeting, shown in Table 3 of Wilkinson (allegedly corresponding to preliminary/final findings) inherently reflect their characterizations as strengths/weaknesses, why would one skilled in the art need or even desire to further label those principles with their respective characterizations. More particularly, borrowing the example in the Official Action, if the principle, “suggested reading were useful in accomplishing workshop goals,” inherently conveys a strength, as alleged (but expressly not admitted), why would one skilled in the art need or desire for the principle to include a label expressly identifying the usefulness of suggested reading as a strength. Indeed, by the logic of the Official Action, such a label would appear duplicative and, therefore, unnecessary.

II. Claims 15-20 are Patentable over Wilkinson

In contrast to independent Claim 15, Wilkinson does not teach or suggest assessing a process of an organization according to a method that includes developing preliminary findings based upon information concerning the organization and the process, where each finding is characterized as either a strength or weakness, as explained above with respect to independent Claim 1. Also in contrast to independent Claim 15, Wilkinson does not teach or suggest voting for agreement or disagreement with strength or weakness characterizations of the preliminary findings. As to the similar subject matter of dependent Claim 6, the Official Action alleges that Wilkinson discloses voting for agreement/disagreement with the theoretical principles of Table 3 and their inherent characterizations. Applicant again respectfully submits, however, that Wilkinson does not in fact inherently (or explicitly) disclose strength/weakness characterizations for the theoretical principles of Table 3. And even further, Wilkinson does not teach or suggest voting for agreement/disagreement with strength/weakness characterizations for the theoretical principles of Table 3 (even if one could argue that the principles inherently include strength/weakness characterizations – although, yet again, expressly not admitted).

For at least the foregoing reasons, Applicant respectfully submits that independent Claims 1, 7 and 15, and by dependency Claims 2-6, 8-14 and 16-20, are patentably distinct from Wilkinson. Thus, Applicant also respectfully requests reversal of the rejection of those claims as being unpatentable over Wilkinson.